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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,710	04/27/2005	Suchiro Mizukawa	MIZU3004/FJD	8789

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EXAMINER
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CRANE, DANIEL C

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

NT

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/532,710	MIZUKAWA, SUEHIRO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel C. Crane	3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/27/2005</u>   | 6) <input type="checkbox"/> Other: ____                           |

## **BASIS FOR OBVIOUSNESS DOUBLE PATENTING OBJECTION**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

## **REJECTION OF CLAIMS ON OBVIOUSNESS DOUBLE PATENTING**

Claims 1-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 7,000,442. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to the skilled artisan having the benefit of the shaping operation and shaping dies that produce a blade from a straight length of material into a rotary die blade using a differentiated compressive force by using a thickness deviating process. It is maintained that the methods and apparatus are the same but differ only in the resulting manner of producing the same result. Accordingly, it would have been obvious to the skilled artisan at the time of the invention to have modified the present method and apparatus by using a thickness deviating

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procedure where different compressive forces are imparted to the workpiece thus, resulting in a deviation in the thickness of the material.

## **BASIS FOR REJECTIONS**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

## **REJECTION OF CLAIMS ON FORMAL MATTERS**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With reference to claim 1, the method is couched in a narrative format which does not lend itself to a clear understanding of the essentially process steps involved in making the blade member. Furthermore, the non-idiomatic English renders the process unclear and difficult to follow. The “dies” of claim 1 are inferred and not positively specified, therefore, the claimed subject matter is vague. Claim 6 positively recites the dies and therefore appears to infer the recitation of the dies within claim 1. This is confusing. Additionally, failure to provide antecedence for “front ends” (claim 1), “length direction” (claims 1 and 4), “linear shape” (claim

2) and “belt-like blade” (claim 4) renders the subject matter indefinite. With reference to claim 4, the phrase “carried out to the blade member” is unclear and therefore renders the subject matter indefinite. As to claim 7, this operation is not clear as to whether it is or is not performed. In this regard, the feature where the method “target” is to have slit-like cut-outs, however, are these cut-outs provided or is this merely a goal of the method? Therefore, the method of claim 7 is vague.

### **REJECTION OF CLAIMS OVER PRIOR ART**

Claims 1, 2, 4-6, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Malm (3,492,903). See Figures 1-3 and the paragraph bridging columns 1 and 2 where a conventional blade bending operation is described. The blade member 15 is pressed by front-end edges 12, 13 and 14 of a pair of dies 10 and 11, respectively, so that impressions 20 are formed on both sides of the blade “near” the blade point 21. These impressions are a result of the contact between the blade and front-end edges of the dies and, thus, the dies “invade and bite” into a portion of the blade. The impressions 20 are shown to be linear in shape. Therefore, the conventional process shown in Figure 3 produces thickness deviating features by virtue of the impressions 20 being formed as a result of the dies 10 and 11 impacting with the blade 15. Since the claims do not specify what constitutes the “width direction” it is maintained that the bending produced by the dies 10 and 11 warp the blade in the “width direction”. Claim 4 has been examined as best understood per the objection set out above.

Claims 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Neilsen (3,926,031). See Figure 3 where the pair of dies 68, 70 are provided with narrowed linear front ends that can be angled at 94 and 96 (see column 3, lines 30-34) with a result of "biting" into the edge of the workpiece B to remove any burrs. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Accordingly, Neilsen's impacting tool is capable of thinning the edge of an elongated workpiece.

Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Chiyoda (Japanese document no. 11-169955). See Figure 10 and 11 where the pair of dies 43 is provided with linear narrowed front edges 43a that move towards and away from one another in an approaching/breaking away manner.

#### **INDICATION OF ALLOWABLE SUBJECT MATTER**

Claims 3 and 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### **PRIOR ART CITED BY EXAMINER**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

## RESPONSE BY APPLICANT(S)

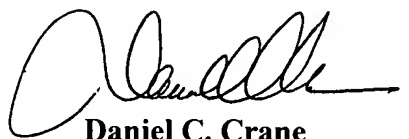
Applicant(s) response to be fully responsive and to provide for a clear record must specifically point out how the language of the claims patentably distinguishes them from the references, both those references applied in the objections and rejections and those references cited in view of the state of the art in accordance with 37 CFR 1.111 (a), (b) and (c).

## INQUIRIES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is **(571) 272-4516**. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday.

Documents related to the instant application may be submitted by facsimile transmission at all times to Fax number (571) 273-8300. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Examiner's Fax number is **(571) 273-4516**.

DCCrane  
November 8, 2006



**Daniel C. Crane**  
Primary Patent Examiner  
Group Art Unit 3725